

Remarks

Claims 2 and 46 have been amended. Review and reconsideration in light of the amendments and the remarks below are requested.

Claim 2 has been amended to address the 35 U.S.C. §112 rejection thereto. Claim 46 has been amended to add further clarification thereof.

Claims 1, 2, 4-14, 16, 28, 29, 49, 42 and 43 are rejected as defining obvious subject matter over Great Britain Patent No. 2,289,520 in light of U.S. Pat. No. 1,906,261 to Glass, and U.S. Pat. No. 5,997,995 to Scianna, and U.S. Pat. No. 4,454,058 to Savit, or in light of alleged admitted prior art.

The GB patent is cited as the primary reference, and the Office action acknowledges that the GB patent does not disclose an upper surface of each sheet being treated to have an anti-static electric property or a reduced static electricity charge. The Office action cites to column 3, lines 1-6 of the Scianna reference as allegedly disclosing the idea of adding a dielectric to a mouse pad, and therefore the desirability of reducing static on mouse pads. However, it is submitted that the Scianna reference does *not* disclose the broad concept of adding a dielectric to a mouse pad.

Instead, and more accurately, the Scianna reference discloses the desirability of adding a thin film or coating 12, having a dielectric material added thereto, to the *bottom* of a *support pad* of the mouse pad. The thin film or coating of the Scianna reference operates as a non-slip surface on the underside of the pad (i.e., to prevent the pad from slipping on a user's desk) (see column 3, lines 1-6; column 2, lines 63-66; column 3, lines 17-18; column 3, lines 7-11 and column 12, line 65) Thus, to the extent the Scianna reference discloses the use of a dielectric material with a mouse pad, it only discloses the use of such dielectric material to the bottom of the support pad of the mouse pad as a tacky gripping surface on the underside of the pad.

The Office action also cites to the Savit reference for the concept of disclosing the idea of coating paper to reduce static on the paper. The Savit reference is directed to technology for use in printing operations, and discloses that a coating may be used to provide improved performance in dielectric copying and printing on the coated paper. In particular, such dielectric printing operations appear to require a conductive substrate with a dielectric coating located

thereon. These configuration apparently allows a through-current to pass through the sheet to improve certain printing operations (column 1, lines 15-23).

The Savit reference discloses the use of dielectric coating should be used in combination with a conductive substrate. The Savit reference acknowledges that paper is typically *not* sufficiently conductive (column 1, lines 23-25) for use in the printing operations disclosed therein. Instead, paper must be impregnated with a chemical solution before it becomes sufficiently conductive to be utilized in the printing process of that reference (column 1, lines 26-28). It is also worth noting that the Savit reference does not include any reference to or discussion of mouse pads, and instead appears to be limited to use with substrates utilized in dielectric printing and copying.

In the "Response to Arguments" section the most recent Office action the use of the Scianna and Savit references in the Office action is clarified. More particularly the Office action indicates:

The examiner is using the Scianna and Savit references together to show the desirability of placing an anti-static coating onto the top surface of a mousepad. The Scianna reference shows that it is desirable to place an anti-static device onto a mousepad and the Savit shows that anti-static coatings can be placed on the top surface of sheets. The combination of references provides the motivation to modify G.B. '520 by attaching an anti-static coating to the top sheets of the mousepad.

However, it is submitted that when the Scianna and Savit references are examined in context, that they do not provide motivation for combining the references in the manner suggested in the Office action. More particularly as noted above, the Scianna reference discloses the use of an *ink formulation*, with a dielectric additive, on the *bottom* of a mousepad *support pad* to *increase tackiness* of the support pad. The Savit reference, in contrast, discloses coating *conductive* paper (which is not disclosed to be utilized in the Scianna reference) to improve performance *in dielectric copying and printing* (which is completely different from the technology of the Scianna reference).

Thus each of the references provide certain teachings in their own technology, but the teachings are each provided in completely distinct areas of technology and provided for reasons which do not necessarily apply to the other references. More particularly, it not clear how a reference that discloses a coating: 1) for use with in dielectric printing operations and 2) used

with paper that is impregnated to make the paper conductive, has any relevance to a reference that discloses: 1) a tacky ink formulation; 2) located on the underside of a mousepad. It is further unclear how the Savit reference (a coating used with electrically conductive paper in dielectric printing operations) would somehow teach one of ordinary skill in the art to move the tacky print formulation of Scianna from the underside of a mousepad, and onto the individual sheets of the mousepad. The Scianna reference does not disclose any dielectric printing operations, or that the individual sheets are even electrically conductive such that they can be used in dielectric printing operations.

The only common concept between the two references is the use of a coating, but the coating is: 1) used on different components (a mousepad base vs. a sheet of paper); 2) serves different functions (a tacky coating vs. a dielectric for printing operations); and 3) is located on differing surfaces of the associated substrate. Thus, it is submitted that one of ordinary skill in the art would not, upon reading the Scianna and Savit references, arrive at a conclusion that it would be obvious to move the dielectric ink formulation of the Savit reference from the bottom of the support pad to the top of the sheets.

In addition it is submitted that Scianna reference specifically teaches against the proposed combination/modification. As noted above the Office action argues that one of ordinary skill in the art would be motivated to use the tacky ink formulation located on the bottom of the mouse pad support on the individual pages of the mouse pad. However the modification would contravene the very purpose and thrust of the Scianna reference. For example, the Scianna reference is titled "NON-SLIP MAT OR PAD." The Abstract of that patent indicates that the mat is a non-slip mat. The Technical Field of the Invention indicates that "The invention disclosed herein relates to an improved nonslip mat or pad...." The Background, Summary, Illustrative Embodiments and claims of the Scianna patent are all directed to a non-slip mat or pad.

Under MPEP §2143.02, if a proposed combination of the prior art would change the principle of operation of the prior art being modified, the teachings of the references are not sufficient to render the claims obvious. In this case, the Office action proposes radically changing the principles of operation of the system of the Scianna reference such that the non-slip

ink formulation is moved off of the bottom of the mouse pad support, thereby vitiating the very purpose and function of that reference.

The Office action, at the bottom of page 3 to the top of page 4, also attempts to provide an independent reason why the combination of the cited references is supported. More particularly, the Office action indicates that it have been obvious to add an anti-static coating to the sheets to "reduce the amount of static electricity stored on the sheets which would prevent damage to electrical components and accumulation of dust and dirt." However, this motivation is identical to that recited in this application. More particularly, at page 3, lines 16-21 of this application, it is noted:

When the sheets 12 have anti-static properties or a low static electricity charge and a mouse is located and rolled or moved across the upper surface of the uppermost sheet 12", the anti-static or low-static nature of the sheet 12" reduces dust accumulation and reduces interference with the electrical components of the mouse to help ensure proper functioning of the mouse. The reduced dust accumulation on the sheets 12 also reduces dust accumulation in the mouse.

MPEP §2145 notes that "any judgment on obviousness is in a sense a reconstruction based on hindsight reasoning, but so long as it . . . *does not include knowledge gleaned only from applicant's disclosure*, such a reconstruction is proper." In this case, the Office action uses an identical benefit cited in the application to reconstruct applicant's invention. None of the cited references recognize the problems caused in the operation of a computer mouse by static electricity which are recognized in this application. No independent motivation for combining the cited reference is provided in the Office action, and the Office action appears to use this application as a template arrive at the claimed invention. Thus it is submitted that the Office action has improperly combined the GB, Savit and Scianna references.

Similarly, page 11, lines 4-12 of Applicant's amendment of November 19, 2004 merely provides a listing of patents which disclose anti-static coatings or treatments. None of these patents appear to disclose the use of anti-static coatings or treatments for use with a mouse pad.

Thus it is submitted that the subject matter of independent claims 1 and 28 is not obvious over the Great Britain, Glass, Scianna and Savit references, or over the alleged admitted prior art.

Claims 1, 2, 4-14, 16, 28, 29, 39, 42 and 43 are rejected as defining obvious subject matter over the GB patent, in view of the Glass reference, and further in view of U.S. Pat. No. 6,187,856 to Incorvia et al. The Office action acknowledges that the GB patent does not disclose

an upper surface of each sheet being treated to have an anti-static electric property or a reduced static electricity charge. The Office action then cites to the Incorvia reference for the idea of adding an anti-static element to a sheet.

However, it is submitted that, when the cited references are considered in their true context, the Incorvia reference does not provide such a teaching. More particularly, the Incorvia reference discloses that it is directed to an anti-static composition for polymeric materials (see, for example, column 1, line 10; column 1, line 18; column 1, lines 20-21; column 1, lines 34-35; column 1, line 46; column 1, line 54; column 2, lines 1-2; column 2, line 28, etc.) At column 2, lines 35-38, the Incorvia reference notes that "Another object of the invention is to provide a process for imparting permanent antistatic properties onto natural and synthetic polymeric substrates." At column 2, lines 40-42, it is noted "The present invention is directed to a new and novel antistatic composition capable of being permanently affixed to a polymeric material." At column 2, lines 61-65, it is noted that "The composition and process of the present invention are also useful for dissipating an electrostatic charge on a static prone natural or synthetic polymeric substrate, thereby imparting a desired level of surface conductivity onto formed plastic articles, such as automobile bumper parts"

Thus, the Incorvia reference is directed to a coating for plastic parts, such as automobile parts. There is no teaching or disclosure for the use of that coating on paper, such as paper sheets of a mouse pad calendar.

In addition, if for some reason one of ordinary skill in the art were to attempt to combine the GB and Incorvia references, the claimed subject matter would not be shown. The GB reference discloses that the mouse pad of that reference includes a "synthetic rubber base" 3 with a cardboard stiffener 2 and papers 1 located thereon. Accordingly, if the Incorvia reference were to be combined with the GB reference, the anti-static properties of Incorvia, which are indicated to be specifically formulated for use with "synthetic polymeric substrates," would be applied to the synthetic material of the GB application; that is, the synthetic rubber base 3, and not the paper sheets 1. There does not appear to be any disclosure in the Incorvia reference that the coatings disclosed therein can even be used on paper. Thus, it is submitted that even if the cited references were to be combined, the subject matter of claim 1 would not be shown.

In addition, these two references do not disclose the problems caused in the operation of the computer mouse by static electricity which are recognized in this application. The Incorvia reference does disclose that electrostatically charged materials may attract dust, dirt and lint, but only discloses this in the context of polymeric textile materials such as garments, upholstery, hosiery, rugs, blankets and fabrics (see column 1, lines 62-64). The Incorvia reference does not include any reference to or discussion of mouse pads, and does not recognize the problems caused by dust accumulating on the papers of a mouse pad, or the specific problems dust can cause with the use of a computer mouse.

Thus it is submitted that claim 1 defines over the GB and Incorvia references. Independent claim 28 is submitted to be allowable for the same or similar reasons as claim 1.

Claims 44-46, 48 and 49 are rejected as allegedly defining obvious subject matter over the GB patent in view of the Glass reference, and in view of U.S. Pat. No. 6,789,340 to Chasnoff, or U.S. Pat. No. 5,351,426 to Voy et al., or U.S. Pat. No. 2,030,135 to Carpenter. With respect to independent claim 44, the Office action acknowledges that the GB and Glass references do not disclose a mouse pad wherein each sheet is not directly joined to any adjacent sheet at an intermediate location of each edge of each sheet, such that a user can slide a finger between adjacent ones of the sheets at the intermediate location along each edge.

The Office action then cites to the Chasnoff, Voy and Carpenter references as allegedly disclosing this feature. The Office action then concludes that, in view of the Chasnoff, Voy or Carpenter references, it would have been obvious to one of ordinary skill in the art to modify the GB reference to place an adhesive only at the corners. However, this rejection is respectfully traversed.

Turning first to the Chasnoff reference, the Office action refers to the adhering component (indicated as reference number 12 in the Office action, but believed to be more properly construed as the "gripping members 5") disclosed therein. However, the gripping members 5 of the Chasnoff reference are disclosed to be made of small hooks or hook-and-loop fastening material, such as VELCRO®. For example, as noted at column 2, lines 48-59, the gripping members 5 are hooks which attach to the fibers of a surface. This text is consistent with the passage at column 1, lines 12-13 which notes "this invention relates to a flat surface display item on a fabric or non-woven fibrous surface."

Accordingly, it is submitted that one of ordinary skill in the art would not be motivated to utilize the VELCRO® gripping members of the Chasnoff reference in the GB reference given the disposable nature of the calendar sheets. It is also submitted that one of ordinary skill in the art would not be motivated to place the VELCRO® gripping members of the Chasnoff reference between each and every sheet of the GB reference to attach the sheets since the VELCRO® materials would add significant thickness to the mouse pad.

In addition, even if the Chasnoff reference is cited for the concept of disclosing an attachment component only at the corners of a unit, the Chasnoff reference discloses only a single set of attachment components 5 at the corners thereof. The Chasnoff reference does not disclose a multi-paged component with VELCRO® gripping members interleaved between each page. Thus, it is submitted that if the Chasnoff reference were, somehow, to be combined with the GB reference, the resultant device would have the attachment components 5 located at the corners of the synthetic rubber pad 3 of the GB reference for attaching the entire stack of papers 1 to the cardboard 2/rubber base 3. In this case, the VELCRO® gripping members are most closely analogous to, and thus would replace, the permanent glue mentioned at page 2, fifth full paragraph, of the GB reference.

In addition, it is submitted that the Office action does not provide sufficient motivation for the proposed combination of the Chasnoff and GB references. At page 7 of the Office action, it is noted that it would have been obvious to modify the GB reference by placing an adhesive only at the corners since this would "allow each sheet to be grasped and removed in an easier and more convenient manner." However, in the device of the Chasnoff reference, the gripping members 5 are located inside a closed pocket/envelope 1. A user would not be able to slide his or fingers between the gripping members 5, except, possibly, along the top edge thereof. Thus, the Chasnoff reference does not provide the motivation provided in the Office action.

In addition, it is submitted that the Office action provides a motivation which is identical to that already provided in this application. For example, at page 4, lines 7-11 of this application, it is disclosed that when it is desired to remove a sheet, the user can slide his or her finger at an intermediate location between the attached corners of the sheets and pull upwardly to break the upper sheet away. As noted above, MPEP §2145 indicates that a judgment of obviousness should not include knowledge gleaned only from the applicant's disclosure.

Thus, in sum, due to the VELCRO® nature of the attachment tab of the Chasnoff reference, the lack of side access to the attachment tabs, and lack of an independent motivation for utilizing the tabs of the Chasnoff reference in the GB reference, it is submitted that claim 44 distinguishes over the Chasnoff reference in combination with the Glass and Incorvia references.

Turning next to the Voy reference, the Office action cites to Fig. 12 for the idea of attaching an adhesive only on the corners of a label. However, similar to the disclosure of the Chasnoff reference above, the Voy reference only discloses an adhesive on the underside of a single label. The Voy reference does not disclose an adhesive for coupling together a plurality of stacked pages, which would require an adhesive to be interleaved between each sheet. Instead, the Voy reference is directed to an improved method for making labels and the like in a variety of shapes and sizes (see column 3, lines 48-52).

Thus, if the disclosure of the Voy reference were to be utilized in the GB reference, the adhesives of that reference would be used to attach the stack of papers 1 to the cardboard 2/synthetic rubber 3 of the GB reference, in place of the permanent adhesive disclosed at page 2, fifth full paragraph. In addition, the Voy reference does not disclose the desirability of placing an adhesive only at the corners to allow sheets to be grasped and removed in an easier and more convenient manner. Instead, as noted above, the motivation provided in the Office action for use of the Voy reference is merely a recitation of advantages specified in this application, which cannot alone be used to support an obviousness rejection.

Finally, turning to the Carpenter reference, that reference discloses an adhesive unit used for attaching paper signs and the like to supporting surfaces such as walls, posts, signboards, and the like (column 1, lines 1-7). Thus, similar to the Voy and Chasnoff references disclosed above, the Carpenter reference does not disclose an adhesive for coupling together a plurality of stacked pages, which would require an adhesive to be interleaved between each sheet. Instead, the Carpenter reference discloses adhesive strips for attaching a single article, such as a poster, to a wall (see column 2, lines 35-52). In addition, it can be seen that the strips of material of the Carpenter reference are relatively thick, and would add significant thickness if interleaved between each sheet of a mouse pad.

Thus, if the Carpenter reference were to be combined with the GB reference, the adhesives of the Carpenter reference would be used to attach the stack of papers 1 to the

cardboard 2/synthetic rubber 3 of the GB reference, in place of the permanent adhesive disclosed at page 2, fifth full paragraph of the GB reference. In addition, the Carpenter reference does not disclose the desirability of placing an adhesive only at the corners to allow sheets to be grasped and removed in an easier and more convenient manner. Instead, as noted above, the motivation provided in the Office action for the proposed recommendation is merely a recitation of advantages specified in this application.

It is noted that the Office may be citing to the Chasnoff, Voy and Carpenter references for disclosing the bare "concept" of locating an adhesive only at the corners of the associated component. However, as noted above, even if this were to be the case it is submitted that the claimed invention is not shown given that the Chasnoff, Voy and Carpenter references are more analogous to the adhesive of the GB reference that attaches the papers to the base, and given the fact that the Office action does not cite to any motivation other than that already cited in this application. In addition, it is submitted that each cited reference must be considered in its totality, and a bare "concept" cannot alone be plucked from a prior art reference. Instead it is submitted that the concept shown in the prior art must be considered in its actual physical manifestation, and if that concept is combined with another (primary) reference it must be done so in the manner disclosed in the (secondary) reference.

Finally is submitted that Applicant's evidence of commercial success retains merit and is probative of the non-obviousness of the invention.

Therefore it is submitted that the application is in a condition for allowance, and a formal notice thereof is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees required, including the fee for an extension of time, or to credit any overpayment to Deposit Account 20-0809. The applicant(s) hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,



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